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GP 2607

In the United States Patent and Trademark Office

In re Application of
Gary R. Tucholski, et al
BATTERIES WITH TESTER LABEL
Serial No. 07/641,394
Filed January 15, 1991

Examiner: Gerald A. Dost
Special Program Examiner

Group Art Unit: Special
Program Examination Unit

34

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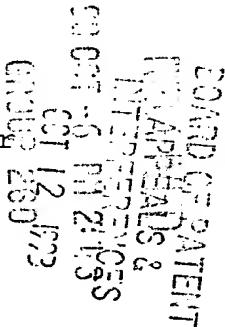
Dana M. Schmidt

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Date: Sept. 30, 1993

United States Patents and Trademark Office
Office of the Assistant Commissioner of Patents
Attention: Gerald A. Dost, Special Program Examiner
Special Program Examination Unit
Crystal Park 2, Suite 919
Washington, D.C. 20231

**PETITION IN REPLY TO
OBJECTION TO ACCESS**



Sir:

Petitioner hereby petitions for review and rejection of the Objection mailed by Applicant on September 23, 1993 in connection with Petitioner's original Petition filed in August, 1993 in this matter.

Petitioner's original and current request is based on MPEP Sec. 103. That section states "the public [Petitioner included] is entitled to see the portion of the earlier application that relates to the common subject matter, and also what prosecution, if any . . . of subject matter claimed in the patent.... If Applicant objects..., he... must submit along with the objection two sets of a copy of the portion of the application that relates to the common subject matter...." (emphasis added.) It does not say, subject

matter that is identical to the issued subject matter. Yet, all that Applicant has supplied is the application as filed, and not that portion of the prosecution history that "relates".

Applicant's Objection mailed on September 23, 1993 relies on the argument that the claims of the issued CIP add a new limitation not pertinent to the prosecution of the parent application. That objection is correct only if the test is, "subject matter that is identical", which as noted above, is not the test. Instead, what Petitioner is entitled to see, and requests, is copies of all pages of the prosecution papers related to method claims directed to "a process for preparing a label comprising a tester for a battery", or the like. Petitioner does not request prosecution history pages that are directed solely to claims, if any, that are properly classifiable as being a device rather than a method.

The reasons and equities of Petitioner's request should be obvious: first, the "new" limitation added by the CIP, and behind which Applicant's Objection seeks to hide, is an article limitation, namely "a layer having a color [etc.]" However, the claims of the issued CIP are method steps of making, the patentability of which may, or may not, have hinged on such a new article limitation. The point is the public cannot tell, without seeing the prosecution history of the parent. The reason the public cannot tell is the CIP is devoid of meaningful prosecution history! The Examiner failed to do his part, as he immediately issued a Notice of Allowability (Paper No. 2) without a statement of "Reasons of Allowability". It is true Applicant filed a Rule 312 Amendment to correct certain typos, Paper No. 7, and a Disclosure Statement, Paper No. 9. However, in neither paper did Applicant allege why the method claims were allowable over the art of record. Applicant having failed to present allowability arguments when it was appropriate to do so (with the Disclosure Statement), should not

now be entitled to deny public access to such arguments in the parent application simply by continuing the prosecution of the parent. Clearly, the intent of Sec. 103 of the MPEP is to provide more access to the parent in such a case than merely a copy of the parent application, as filed.

Access is therefore appropriate and needed. If Applicant persists in refusing to provide copies of the relevant pages, then complete access to the entire file is requested as per MPEP Sec. 103.

Please charge the PTO fee, if any, for this Petition, to Deposit Order Account No. 050225.

Respectfully submitted,

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Certificate of Service

This certifies that a copy of the foregoing Petition was served on counsel for Applicant by mailing on Sept. 30, 1993, first class mail, postage prepaid, to:

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